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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/758,987

01/16/2004

Jeffrey Douglas Lloyd

61761.US

7899

7590 09/07/2007  
LUEDEKA, NEELY & GRAHAM, P.C.  
P.O. Box 1871  
Knoxville, TN 37901

EXAMINER
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LEVY, NEIL S

ART UNIT	PAPER NUMBER
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1615

MAIL DATE	DELIVERY MODE
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09/07/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/758,987

Applicant(s)

LLOYD ET AL.

Examiner

NEIL LEVY

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 1-14, 22, 23 and 27-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-21, 24-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-38 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## DETAILED ACTION

### *Election/Restrictions*

Applicant's election with traverse of Group II, species sodium borate, cement, and spraying in the reply filed on 7/30/07 is acknowledged.

The traversal is on the ground(s) that The groups are sufficiently related to be searched together and constitute less than a serious burden.

This is not found persuasive because Examiner finds for reasons of record the groups to be patentably distinct and would require added time to search and examine, constituting a serious burden.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-14, 22, 23, 27-38 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention & species there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 7/30/07

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claim 15-17, 19-21, 24, 26 are

rejected under 35 U.S.C. 102(b) as being anticipated by TIERNAN et al 5346699

Termites isoptera are controlled by borates (column 5, bottom) applied in a solution as foam spray (column 6, claim 2) to a concrete slab.

Claim 15-17, 19-21, 24-26 are

rejected under 35 U.S.C. 102(b) as being Anticipated by TOBIN-JP 200/220837.

See abstract-sodium borate applied to polystyrene, applied to concrete, man-made structures, providing termite barrier.

Claim 15 is rejected under 35 U.S.C. 102(e) as being anticipated by BARTDORF 6881247

Borate solutions are applied by spraying as coatings on construction materials to protect against termites. Applying the instant compositions could provide the same effects as instantly claimed; prevention of tube termites and termite damage.

Claim 15, 17, 19, 20, 25, and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by MANNING et al 7163974

Straw, rice (column 3, lines 27-32) are coated with pesticidal amounts (column 4, lines 50 line- 1 of column 5) of calcium borates (lines 27-42) by incorporation with borates and adhesive solvent (Example) by pressure immersion. The products are non-wood, as they are composites of the cellulose and binder, but are used as building materials. The instant termites would be protected against since the same borates with non-wood components are prepared.

Claim 15, 17, 19, 20, 25, and 26 are

rejected under 35 U.S.C. 102(b) as being anticipated by LLOYD et al 6368529.

As above, non-wood components (column 2, lines 56-61; Example 1) provide cellulosic or wood-resin structural composites (column 3, bottom; column 4, top; and claims) which are termite protected (column 3, lines 60-63).

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Claim 15-17, 19, 20, 24-26 are  
rejected under 35 U.S.C. 102(e) as being anticipated by LLOYD et al. US  
2007/0122442

Solutions of sodium borate [0009] at insecticidal amounts [0015] are incorporated into non-wood components-binder or cellulosic [0017, 0018]. Efficacy is shown against captotermes [0033]. Solvent is sufficient water to slurry binder [0019].

Claim 15-17, 19, 20, 24-26 are rejected under 35 U.S.C. 102(e) as being anticipated  
LYOYD et al 6896908

Here, too, lignocellulosics (summary) are treated with DOT (column 3, paragraph 3) concentrate (3-45%) solutions at 10-12 times concentrations of the diluted treatment solutions (column 5, top). Lignocellulosic treatment is by spraying, dipping, brushing (column 7, top). As above, inherently, captotermes would be protected against.

Claim 15-20, 24-26 are  
rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over BLOUNT-6423251 plastics (column 2, top) treated with 15-30% borates (A-1) glycol (column 2, lines 53-54) and water (D) are termiticidal (summary). Building components protected by spraying are paper, fabrics, rubber, cellulotics, and plastics (column 5, lines 52-60) to provide coated products (column 7, lines 47-57) such as shingles. See Examples 24, 25.

The same compositions are used by BLOUNT, so would protect in the instant manner.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claim 15-21, 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over TIERNAN et al in view of LLOYD et al 6368529 and BLOUNT.

TIERNAN (above) provides borates in general by spraying concrete surfaces with emulsions, but surfactants and borates are not specified. LLOYD (above) shows any of the borates including DOT (column 1, lines 25-35) are termicidal, thus obvious for use to kill or protect against termites. BLOUNT further shows the borates with surfactants of glycol (above).

### ***Double Patenting***

Claim 15-17, 19, 20, 24-26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 18-23 of U.S. Patent No. 6368529. Although the conflicting claims are not identical, they are not patentably distinct from each other because The treatment is termicidal, thus providing the claimed effects of the instant application

Claims 15-17, 19, 20, 24-26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 7163974. Although the conflicting claims are not identical, they are not patentably distinct from each other because The treatment is termicidal, thus providing the claimed effects of the instant application

Claim 15-17, 19, 20, 24-26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 18-22 of copending Application No. 10/332549. Although the conflicting claims are not identical, they are not patentably distinct from each other because The treatment is termicidal, thus providing the claimed effects of the instant application

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

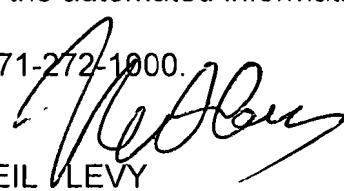
Any inquiry concerning this communication or earlier communications from the examiner should be directed to NEIL LEVY whose telephone number is 571-272-0619.

The examiner can normally be reached on Tuesday-Friday, 7 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



NEIL LEVY  
Primary Examiner  
Art Unit 1615

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